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MCADAMS, BRAD				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/501,944

Applicant(s)

POIKSELKA ET AL.

Examiner

ROBERT B. MCADAMS

Art Unit

2456

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 32-43 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-20 and 32-43 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

DETAILED ACTION

1. This Office Action is in response to the communication filed on June 29, 2009.
2. Claims 1-20 and 32-43 are pending.

Response to Amendment

3. Applicant's Pre-Brief Conference request, filed 06/29/2009, for reconsideration of the finality of the last Office Action, mailed 01/29/2009, is persuasive and, therefore, the finality of said action is withdrawn. The After-Final Amendment filed on April 22, 2009 is therefore void and will not be entered. A new Final action in response to the arguments, filed 09/29/2008, will be provided in this action.

Response to Arguments

4. Applicant's arguments filed 09/29/2008 have been fully considered but they are not persuasive. The Applicant argues, page 12 and 15, *Denenberg* does not disclose detecting a change in subscription information of a subscriber; checking whether a capability of a network element serving a terminal device of said subscriber is still in accordance with said changed subscription information; and initiating in response to the result of said checking a registration procedure for registering said terminal device of

said subscriber to a new serving network element. The Examiner respectfully disagrees.

As to "detecting a change in subscription information of a subscriber. . ." the Applicant argues that *Denenberg*, Column 4, Lines 35-42 describes a *first time* activation process. *Denenberg* disclosed an exemplary embodiment detecting a change in subscription information. In another embodiment, *Denenberg* describes where subscription change can be detected at anytime, before or after registration.

"This service registration call can occur at initial activation of the wireless device or, alternatively the call could be received at a time subsequent to activation when the user decides to take advantage of a new service offering or to change service subscriptions."

(Figures 5 and 6; Paragraph bridging Columns 7 and 8).

As to "initiating . . . a new network element.", the Applicant argues that *Denenberg*, Column 4, Lines 35-42 fails to suggest a checking the capability of a *network element*. *Denenberg* discloses wherein the network element is determined to be eligible to receive the service, and if so, registering the subscriber to the network element

*"A decision step then determines whether the **subscriber location** is eligible to receive the service, step 607. Alternatively, if the location is eligible then the system may **register** the ESN..."*

(Figure 6; Column 8, Lines 25-33).

As to **Claim 5**, the Applicant argues that *Denenberg* fails to suggest "wherein said checking is performed on a basis of a capability information added based on said

detecting a response message of a re-registration procedure initiated by said terminal device". The Examiner respectfully disagrees.

Denenberg teaches when a subscriber changes his subscription information, the capability information of the network elements and terminal device are checked, and in the situation of incapability, an alternate plan is offered and the system detects a response to re-register under the alternate plan initiated and by the terminal device (**Column 5, Lines 23-42 and Column 8, Lines 19-24**).

As to **Claim 8**, the Applicant argues that *Denenberg* fails to suggest "a configuration information provided for determining subscribed services needing predetermined serving network elements." The Examiner respectfully disagrees.

Denenberg teaches wherein the administrative center 180 contains a database that includes configuration information for determining which subscribed services needing predetermined serving network elements (**Figures 2-4; Column 6, Lines 41-54**).

Specification

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. There is no teaching in the specification that enables the Office to establish the metes and bounds of the claimed "system" in Claim 44.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1-20, 32-37, 40-42** are rejected under 35 U.S.C. 102(e) as being anticipated by *Denenberg* (U.S. Patent No. 6,859,649 B1).

8. As to **Claims 1-4**, *Denenberg* discloses detecting a change in said subscription information of said subscriber (**Changes in subscription information to different services are detected. Figures 5 and 6; Paragraph bridging Columns 7 and 8 and Column 4, Lines 35-42**);

checking whether a capability of a network element serving a terminal device of said subscriber is still in accordance with said changed subscription information (**The network element is determined to be eligible to receive the service, and if so, registering the subscriber to the network element. Figure 6; Column 8, Lines 25-33**); and

initiating in response to the result of said checking step a registration procedure for registering said terminal device of said subscriber to a new serving network element

(In response to checking capability, the terminal device is registered to the new network element. Figure 6; Column 8, Lines 25-33).

As to **Claims 5-7**, *Denenberg* further discloses wherein said checking step is performed on the basis of a capability information added based on said detection step to a response message of a re-registration procedure initiated by said terminal device **(In the event of subscriber information incompatibility, said terminal device is de-registered and given alternate capability information for re-registration during the activation periods. Column 5, Lines 23-42 and Column 8, Lines 19-24).**

As to **Claims 8 and 19-20**, *Denenberg* further discloses wherein a configuration information is provided for determining subscribed services needing predetermined serving network elements **(Administrative Center 280 provides configuration information for terminal devices and network elements, predetermining which network elements are subscribable. Figures 2-4; Column 6, Lines 41-54 and Column 5, Lines 43-62).**

As to **Claims 9-18**, *Denenberg* further discloses wherein said checking step comprises the steps of

transmitting a capability query comprising an information indicating at least one required capability to said serving network element **(The subscriber provides a required capability (home location)),**

comparing capabilities of said serving network element with said information about said at least one required capabilities (**The required capability is compared with eligibility database by the interrogator**), and

receiving an acknowledgment indicating the result of said comparing step from said serving network element (**An acknowledgment is received from the comparing step. If said elements are compatible then subscriber is passed through the proxy network element to be registered, else the subscriber is de-registered and given an alternative selection of compatible network elements for re-registration.**) (Column 5, Lines 10-43).

Apparatus **Claims 32-36** correspond to method **Claims 1-20** and are therefore analyzed and rejected the same as previously discussed with respect to **Claims 1-20**.

As to **Claim 37**, *Denenburg* teaches a processor receiving a de-register message containing a cause information, which indicates the reason for the de-register message, and in response to said de-register message, to initiate automatically a new initial registration procedure for registering said apparatus to a new serving network element providing session control services for said apparatus, if a result of a checking operation for checking a capability of a current serving network element indicates that the capability is not in accordance with a change in subscription information of said subscriber (**The system receives a de-register message from the subscriber with the cause information suggesting incompatible subscription information. The**

system initiates a new registration procedure with an alternate billing plan if the checking operation determines the capability is not in accordance with the change in subscription. Column 5, Lines 23-42 and Column 8, Lines 19-24).

As to **Claim 40**, *Denenburg* discloses an apparatus, comprising a processor configured to check whether a capability of a current serving network element serving a terminal device of a subscriber is still in accordance with a change in subscription information **(The system determines wherein the network element is determined to be eligible to receive the new service, and if so, registering the subscriber to the network element. Figure 6; Column 8, Lines 25-33).**

As to **Claim 41**, *Denenburg* further discloses sending a registration authorization message to a subscriber database in response to a registration message for a new registration of a terminal device **(Step 615, Figure 6; Column 8, Lines 25-33).**

As to **Claim 42**, *Denenburg* further discloses a further processor configured to initiate a registration procedure for registering said apparatus to a new serving network element, based on the result of said processor **(The system determines wherein the network element is determined to be eligible to receive the new service, and if so, registering the subscriber to the network element. Figure 6; Column 8, Lines 25-33).**

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 38 and 39** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Denenberg* (U.S. Patent No. 6,859,649 B1) in view of *Wang* (U. S. PGPub No. 2002/0131395).

As to **Claims 38 and 39**, *Denenberg* discloses apparatus as previously discussed in Claim 37.

However, *Deneburg* does not expressly disclose wherein said de-register message is a message in accordance with a session initiation protocol NOTIFY-message.

Wang, in the same field of endeavor, teaches sending messages over a session initiation protocol using NOTIFY-messages (**Paragraph 0038**).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to have combined sending de-register messages in the apparatus, as taught by *Deneburg*, to wherein said de-registration messages are in accordance with a session initiation protocol as taught by *Wang*. The motivation would have been to use a standard protocol for communication.

11. **Claim 43** is rejected under 35 U.S.C. 103(a) as being unpatentable over *Denenberg* (U.S. Patent No. 6,859,649 B1) in view of *Sanchez* (U.S. PGPub. No. 2002/0147845).

As to **Claim 43**, *Denenberg* teaches the apparatus as previously discussed in Claim 40.

However, *Denenberg* does not expressly disclose the apparatus is an interrogating call state control function of an Internet Protocol Multimedia Subsystem.

Sanchez, in the same field of endeavor, describes using an interrogating call state control function of an Internet Protocol Multimedia Subsystem (**Paragraph 0009**).

At the time of invention, It would have been obvious to one of ordinary skill in the art to combine the apparatus as taught by *Denenberg* with an interrogating call state control function as taught by *Sanchez*. The motivation would have been to use standard communication servers.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT B. MCADAMS whose telephone number is (571)270-3309. The examiner can normally be reached on Monday-Thursday 6:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. B. M./
Examiner, Art Unit 2456

/Bunjod Jaroenchonwanit/
Supervisory Patent Examiner, Art Unit 2456